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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,636	09/27/2001	Bradley D. Mierau	13-110	9698
23117	7590	11/28/2003	EXAMINER	
NIXON & VANDERHYE, PC 1100 N GLEBE ROAD 8TH FLOOR ARLINGTON, VA 22201-4714			SAVAGE, MATTHEW O	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 11/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,636

Applicant(s)

MIERAU ET AL.

Examiner

Matthew O Savage

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4, 13-18, 21, 22 and 24-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-9, 12, 19 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8-27-03. 6) ☐ Other:

Applicant's election with traverse of group I and species 3 in the response filed on 8-27-03 is acknowledged. The traversal is on the ground(s) that: 1) the combinations are linked to the subcombinations; 2) all of the species require a vent tube; 3) claims 3, 4, 10, and 11 should be examined since the elected species requires an annular volume.

This is not found persuasive because: 1) the combinations do not require all of the particulars of the subcombination including those mentioned in the requirement for restriction; 2) the elected species does not include a vent tube; 3) the elected species does not have an annular volume since the outer body includes a spout and cannot be circular .

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 5-9, 12, and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The concept of the bodies and static treatment media being positioned so that liquid is visible in the volume but so the media is not visible exteriorly of said outer body has not been adequately disclosed in the specification. Specifically, the media is

visible from either the ports 64, exit port 66, or when the cover 71 is removed in the case of the elected species shown in FIG. 6.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-9 and 12 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 5, defining the filter media with respect to a federal rule is considered vague and indefinite since the rule is subject to change.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeAre in view of Fish et al.

With respect to claim 1, DeAre discloses vessel 10 capable of holding and dispersing liquid, including an outer body 10 having a side, and a substantially closed bottom; a hollow inner body 16, 18, and having an interior, said inner body spaced from said outer body to define a volume therebetween; static liquid treatment media 54, 56, 58 disposed within the inner body; a liquid passageway 44 between said inner body

interior and said volume allowing the flow of liquid from said inner body to said volume, but substantially precluding passage of static treatment media from said inner body to said volume; an open end (e.g., surrounded by peripheral shoulder 18) at a first end of said bodies opposite the substantially closed bottom through which liquid may enter said inner body interior; a closure 22 for the open end. DeAre fails to specify the outer body as being transparent. Fish et al discloses that it is known in the art to provide an outer body 12 that is transparent (see lines 1-3 of page 3) and suggests that such a modification enables viewing of the level of purified liquid held within the outer body. It would have been obvious to have modified the apparatus of DeAre so as to have included an outer body that was transparent as suggested by Fish et al in order to enable viewing of the level of purified liquid within the container. DeAre and Fish et al fail to specify the inner body as being opaque, however, such a modification is considered nothing more than an aesthetic design change and is not considered patentable (see M.P.E.P. 2144.04 I).

As to claim 2, DeAre and Fish et al fail to specify the inner body as being substantially opaque where substantially aligned with said transparent or translucent portion of said outer body, however, such a modification is considered nothing more than an aesthetic design change and is not considered patentable (see M.P.E.P. 2144.04 I).

Concerning claim 19, Fish et al disclose the entire side of the outer body as being transparent.

Claims 1, 2, 5-9, 12, 19, and 23 are rejected under 35 U.S.C. 103(a) as being obvious over Nohren et al in view of Fish et al.

The applied reference has common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

With respect to claim 1, Nohren et al disclose vessel 1 capable of holding and dispersing liquid, including an outer body 1 having a side, and a substantially closed bottom; a hollow inner body 13, 17 and having an interior, said inner body spaced from said outer body to define a volume 2 therebetween; static liquid treatment media 4

disposed within the inner body; a liquid passageway 7 between said inner body interior and said volume allowing the flow of liquid from said inner body to said volume, but substantially precluding passage of static treatment media from said inner body to said volume; an open end (e.g., the upper end) at a first end of said bodies opposite the substantially closed bottom through which liquid may enter said inner body interior; a closure 10 for the open end. Nohren et al fail to specify the outer body as being transparent. Fish et al discloses that it is known in the art to provide an outer body 12 that is transparent (see lines 1-3 of page 3) and suggests that such a modification enables viewing of the level of purified liquid held within the outer body. It would have been obvious to have modified the apparatus of Nohren et al so as to have included an outer body that was transparent as suggested by Fish et al in order to enable viewing of the level of purified liquid within the container. Nohren and Fish et al fail to specify the inner body as being opaque, however, such a modification is considered nothing more than an aesthetic design change and is not considered patentable (see M.P.E.P. 2144.04 I).

As to claim 2, Nohren et al and Fish et al fail to specify the inner body as being substantially opaque where substantially aligned with said transparent or translucent portion of said outer body, however, such a modification is considered nothing more than an aesthetic design change and is not considered patentable (see M.P.E.P. 2144.04 I).

The limitations of claims 5-9 and 12 are disclosed from line 54 of col. 16 to line 15 of col. 17.

Concerning claim 19, Fish et al disclose the entire side of the outer body as being transparent.

Regarding claim 23, Nohren et al disclose the media as having a void volume mean value of about 6-7 times 10^{-8} liters (e.g., see lines 33-35 of col. 11, or lines 5-9 of col. 12).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,602,406 in view of Fish et al.

With respect to instant claim 1, an outer body 1 having a side, and a substantially closed bottom (see claims 1 and 3); a hollow inner body 13, 17 and having an interior, said inner body spaced from said outer body to define a volume 2 therebetween (patent claim 3); static liquid treatment media 4 disposed within the inner body (patent claim 1);

a liquid passageway 7 between said inner body interior and said volume allowing the flow of liquid from said inner body to said volume, but substantially precluding passage of static treatment media from said inner body to said volume (claim 1); an open end at a first end of said bodies opposite the substantially closed bottom through which liquid may enter said inner body interior (see patent claims 1 and 3); a closure 10 for the open end (see patent claim 4). Nohren et al fail to specify the outer body as being transparent. Fish et al discloses that it is known in the art to provide an outer body 12 that is transparent (see lines 1-3 of page 3) and suggests that such a modification enables viewing of the level of purified liquid held within the outer body. It would have been obvious to have modified the apparatus of Nohren et al so as to have included an outer body that was transparent as suggested by Fish et al in order to enable viewing of the level of purified liquid within the container. Nohren and Fish et al fail to specify the inner body as being opaque, however, such a modification is considered nothing more than an aesthetic design change and is not considered patentable (see M.P.E.P. 2144.04 I).

As to claim 2, Nohren et al and Fish et al fail to specify the inner body as being substantially opaque where substantially aligned with said transparent or translucent portion of said outer body, however, such a modification is considered nothing more than an aesthetic design change and is not considered patentable (see M.P.E.P. 2144.04 I).

Concerning claim 19, Fish et al disclose the entire side of the outer body as being transparent.

Application/Control Number: 09/963,636
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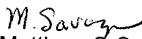
Page 9

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O Savage whose telephone number is 703-308-3854. The examiner can normally be reached on Monday-Friday, 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda W. Walker can be reached on 703-308-0457. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Matthew O Savage
Primary Examiner
Art Unit 1723

mos
November 20, 2003